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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,691	03/14/2002	Paulina Glavich	0112300-994	5155

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EXAMINER
JONES, SCOTT E

ART UNIT	PAPER NUMBER
3713	12

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/098,691	GLAVICH ET AL.	
	Examiner	Art Unit	
	Scott E. Jones	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 June 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-62* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-62* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 March 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *10* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment and request for continued examination filed on June 19, 2003 in which applicant amends claims 1, 6, 9, 12, 17, and 21, adds new claims 26-62, and responds to the claim rejections.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 19, 2003 has been entered.

Claim Objections

3. It is noted that claims 16, 20, and 24 recite "the Internet". While the term "Internet" is trademarked for goods and services, it is not presently trademarked for the service of a computer network. However, it is a term that is relative given both the rate at which technology is evolving, and misuse by modern media. The Internet is an infrastructure that supports the transmission of electronic data. It consists of all servers, routers, telephone lines, satellites, and other communications instruments used to convey electronic data, including Web sites, e-mail, usenets, and newsgroups, from one point to another. By using the term Internet, Applicant must be careful to delineate whether intending to claim the infrastructure of the Internet, or use of the infrastructure. Furthermore, what is accepted as the conventional scope of the Internet today, in terms of infrastructure, is quite different from that which was accepted as briefly as five years

ago, and it is unknown what will be accepted as the "Internet" of tomorrow. For these reasons, it is strongly urged that Applicant consider using more generic computer network terminology to claim the invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5, 12, 14-15, 25-29, 40-44, and 55-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Fasbender et al. (U.S. 2002/0086725 A1).

Regarding Claims 1, 6, 9, 12, 17, 21, and 55:

- a display device (Figs. 2-11);
- a primary/base game displayed on the display device (¶ 17);
- a set of reels in the primary/base game having a plurality of symbols (¶'s 17-21 and 36);
- a plurality of primary/base game awards associated with the primary/base symbols (¶'s 18, 35, 42, 45, and 55);
- a first secondary/bonus game(20) displayed on the display device (Abstract, Fig. 1, ¶'s 2, 17-21, 36, and 58);
- a set of reels in the first secondary/bonus game having a plurality of symbols which include at least one different symbol than the primary/base symbols (¶ 37);

- a second secondary/bonus game displayed on the display device (Abstract, Fig. 1, ¶'s 2, 17-21, 36, and 58);
- a plurality of secondary/bonus awards associated with the secondary/bonus symbols in each of the secondary/bonus games, wherein the secondary/bonus awards are different than the primary/base awards (¶ 45); and
- a processor causes the display device to display the set of reels in the primary/base game which are randomly determined, provides any primary/base awards associated with the primary/base symbols indicated on the reels in the primary/base game, causes the display device to remove/replace the set of reels in the primary/base game with the set of reels in the first secondary/bonus game when a first triggering event occurs in the primary/base game, randomly determines the secondary/bonus symbols indicated by the set of reels of the first secondary/bonus game, provides any secondary/bonus awards associated with the secondary/bonus symbols indicated on the reels in the first secondary/bonus game, and causes the display device to replace the set of reels in the first secondary/bonus game with the second secondary/bonus game when a second triggering event occurs in the first secondary/bonus game, wherein the primary/base game does not include a triggering event which causes the processor to cause the display device to display the second secondary/bonus game (Abstract, Fig. 1, ¶'s 2, 17-21, 36-37, and 57-58).

Regarding Claims 2 and 7:

- a plurality of the secondary/bonus symbols of the first secondary/bonus game are different than the primary/base symbols (¶ 37).

Regarding Claims 3, 8, 10, 14, 18, and 22:

- all of the secondary/bonus symbols of the first secondary/bonus game are different than the primary/base symbols (¶ 37).

Regarding Claim 5:

- the second secondary game includes second secondary symbols which are different than the secondary symbols of the first secondary game (¶ 37).

Regarding Claims 25 and 40:

- at least one of the secondary awards is larger than all of the primary awards (¶ 45).

Regarding Claims 26 and 41:

- the secondary awards in the secondary game are different than the secondary awards in the first secondary game (¶ 45).

Regarding Claims 27 and 42:

- at least one of the secondary awards in the second secondary game is greater than all of the secondary awards in the first secondary game (¶ 45).

Regarding Claims 28, 43, and 55:

- a probability of obtaining a winning combination of symbols associated with each winning combination of the primary symbols in the primary game and each winning combination of the secondary symbols in the first secondary game, wherein the probabilities associated with the winning combinations of secondary

symbols are different than the probabilities associated with the winning combinations of primary symbols (¶ 45).

Regarding Claims 29, 44, and 56:

- at least one of the probabilities associated with the winning combinations of secondary symbols in the first secondary game is greater than all of the probabilities associated with the winning combinations of primary symbols in the primary game (¶ 45).

Regarding Claim 57:

- the probabilities associated with winning combinations of secondary symbols in the second secondary game are different than the probabilities associated with winning combinations of secondary symbols in the first secondary game (¶ 45).

Regarding Claim 58:

- at least one of the probabilities associated with the winning combinations of secondary symbols in the second secondary game is greater than all of the probabilities associated with the winning combinations of secondary symbols in the first secondary game (¶ 45).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fasbender et al. (U.S. 2002/0086725 A1).

Fasbender et al. discloses that as discussed above regarding Claims 1-3, 5, 12, 14-15, 25-29, 40-44, and 55-58. Fasbender et al. seems to lack explicitly disclosing that a gaming device is operated through the Internet. However, operating gaming machines over a data network such as the Internet was well know to one having ordinary skill in the art at the time of the applicant's invention. One would be motivated to do so because this provides an efficient and cost effective way to collect personal data from a game player or to reconfigure a gaming machine thereby possibly reducing the number of employees required to run a casino.

8. Claims 4, 6-11, 13, 17-24, 30-39, 45-54, and 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fasbender et al. (U.S. 2002/0086725 A1) in view of Watts et al. (U.S. 5,775,692).

Fasbender et al. discloses that as discussed above regarding Claims 1-3, 5, 12, 14-15, 25-29, 40-44, and 55-58. Fasbender et al. seems to lack explicitly disclosing:

Regarding Claims 4, 6, 9, 11, 13, 17, 21, and 59:

- the gaming device includes less secondary/bonus symbols of the first secondary/bonus game than the primary/base symbols (Column 1, lines 59-67, Column 2, lines 35-39).

Regarding Claims 20 and 24:

- operating gaming machines over a data network such as the Internet.

Watts et al. teaches of a gaming machine having a base game and secondary game(s). A predetermined outcome in the primary game triggers a first secondary game. Additional stages in the secondary game(s) can be implemented that are not triggered by the predetermined outcome in the

primary game. Watts et al. and Fasbender et al. are analogous art since both describe slot machines having base and bonus games. Furthermore, Watts et al. teaches:

Regarding Claims 4, 6, 9, 11, 13, and 21:

- the gaming device includes less secondary/bonus symbols of the first secondary/bonus game than the primary/base symbols (Column 1, lines 59-67, Column 2, lines 35-39).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate fewer symbols in a bonus/secondary game as taught in Watts et al. in Fasbender et al. One would be motivated to do so because having less symbols on a secondary/bonus reel improve the overall odds of a player receiving an award in the bonus/secondary round.

Regarding claims 20 and 24, operating gaming machines over a data network such as the Internet was well know to one having ordinary skill in the art at the time of the applicant's invention. One would be motivated to do so because this provides an efficient and cost effective way to collect personal data from a game player or to reconfigure a gaming machine thereby possibly reducing the number of employees required to run a casino.

Response to Arguments

9. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wain '019, Gauselmann '233, Nagano '165, Crawford et al. '412, Jaffe '432, '187,

O'Halloran '993, Last '380, and Hamano et al. '735 disclose gaming machines having base and bonus games wherein symbols in a base game are replaced with symbols from a bonus game.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Friday, 8:30 A.M. - 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

SEJ
sej
August 8, 2003

MICHAEL O'NEILL
PRIMARY EXAMINER